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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/603,832	06/26/2003	Tokimori Tomita	122.1046CD2	4081

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STAAS & HALSEY LLP  
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1201 NEW YORK AVENUE, N.W.  
WASHINGTON, DC 20005

EXAMINER
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ALVAREZ, RAQUEL

ART UNIT	PAPER NUMBER
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3622

MAIL DATE	DELIVERY MODE
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12/31/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/603,832

**Applicant(s)**

TOMITA ET AL.

**Examiner**

Raquel Alvarez

**Art Unit**

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 14, 17, 20, 23 and 25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14, 17, 20, 23 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This office action is in response to communication filed on 10/11/2007.
2. Claims 1-13 have been cancelled.
3. Claims 14, 17, 20, 23 and 25 are presented for examination.

### **Claim Rejections - 35 USC § 103**

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 14, 17, 20, 23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deaton (6,684,195 hereinafter Deaton) in view of Official Notice.

With respect to claims 14, 17, 20, 23 and 25 Deaton teaches a point management system employing a computer for managing points issued to each customer who receives a service according to the issued points (Abstract). Point issue means for issuing points to a customer according to transaction performed by the customer (see Figure 18B and col. 75, lines 33-38); point accumulation means for calculating and accumulating the issued points, in proportion to a time used for providing an information service according to the cumulative points (i.e. the incentives or points accumulated are based on the purchases made within a selected time period or whether the store has the product in inventory, the incentive may be changed)(Figure 18C, items 38,39,42,43, 46, col. 73, lines 45-57, col. 75, lines 33-38 and col. 103, lines

50 to col. 104, lines 1-21 ); service providing means for providing the information to a customer (col. 103, lines 64 to col. 104, lines 1-21).

Deaton doesn't specifically teach that the services provided are video information, voice information, software information, music information and database information as the electronic information to the customer through a communication circuit. Official notice is taken that it is old and well known in the computer related arts to provide services electronically such as video information, voice information, software, music and database information to the customer via the customer's PC in order to avoid the need for the customer to having to wait for the goods or services or having to pick up the goods or services from a remote location. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included providing services/items electronically such as video information, voice information, software, music and database information via his or her PC in order to obtain the above mentioned advantage.

With respect to newly amended feature of calculating and accumulating the issued points and subtracts from the cumulative points in proportion to the time used for providing an electronic information service. Deaton teaches on col. 103, lines 50-63 reducing the value of the incentives or points accumulated over a pre-selected time interval if the customer doesn't receive or respond to the promotion or service within the time allotted.

With respect to displaying the customer's cumulative points. Since Deaton teaches on col. 73, lines 55-57 adding or subtracting the incentives/points according to

a proportion of time (col. 75, lines 33-38, col. 103, lines 50 to col. 104, lines 1-21) then it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included displaying the points in order to provide the customer with a visual representation of the points.

### **Response to Arguments**

6. In the "Remarks" section, Applicant is referring to claim 1, claim 1 has been cancelled. The Examiner is assuming that this was a typo and that Applicant is referring to claim 14.

7. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e. partial redemption of a coupon) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The claims read as follows "decreasing the cumulative points proportionally to elapse of time during a time an electronic information service is provided to a customer terminal" In Deaton, the customer's points are decreased in proportion to the time that it takes the customer to buy or to be provided the goods or services. For example, the customer is provided with goods or services to be purchased and points or coupons to make the purchases, if the customer doesn't redeem the goods or services from the time the good or service is being advertised or

provided to the customer then the accumulated points start to decrease (col. 103, lines 50 to col. 104, lines 1-62). Applicant is reminded that the claims are given their broadest interpretation and if Applicant feels that Examiner interpretation is incorrect then Applicant must point out as to why Examiner's interpretation of the claims is incorrect or otherwise, Applicant must amend the claims so that they can't be interpreted in any other way. Also, Applicant is to point for support in the specification.

8. With respect to displaying the customer's cumulative points. Since Deaton teaches on col. 73, lines 55-57 adding or subtracting the incentives/points according to a proportion of time (col. 75, lines 33-38, col. 103, lines 50 to col. 104, lines 1-21) then it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included displaying the points in order to help the customer manage his or her points by allowing the customer to have a visual representation of the points that have been added or subtracted from the account.

9. With respect to the Official Notice taken that the service or items are electronically provided using a customer terminal. The Examiner wants to point out that in the computer related arts software, music and the like is provided to the customer in electronic format. For example, iTunes is a media player of Apple Computer and is used for transferring music, photos and videos. The user can purchase digital music files from within iTunes.

10. With In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention

where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Applicant argues that decreasing the value of the points while providing the service which is taught by Deaton, can't be combine with the official notice of the goods or service being provided electronically. The Examiner disagrees with Applicant because as stated above that combining Deaton goods or services with well known electronic goods and services is a knowledge that one of ordinary skilled in the art given the Deaton reference of tangible goods or services will know that providing goods or services available electronically such as the case of music and videos will provide a convenience to the purchasing customer who can now receive the goods or services without leaving their desks.

**Point of contact**

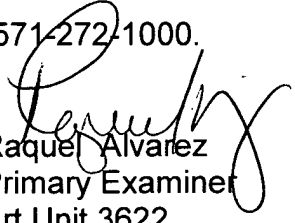
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (571)272-6715. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w. Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Raquel Alvarez  
Primary Examiner  
Art Unit 3622

R.A.  
12/19/2007